

Office Action Summary

Application No.

10/577,619

Applicant(s)

LEHMANN ET AL.

Examiner

NICOLE M. BUJE

Art Unit

1796

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10-19 is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☒ Claim(s) 3, 9 and 20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
- 4) ☒ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date 20070125 / 20081204
- Paper No(s)/Mail Date 20090223

DETAILED ACTION

Information Disclosure Statement

Each of the documents cited in the information disclosure state filed on 02/23/2009 have been already submitted and considered as part of the information disclosure statement filed on 01/25/2007.

Specification

It is noted that abstract filed on 01/25/2007 is the latest amendment, and the instant specification filed on 12/04/2008 appears to be the original specification.

The disclosure is objected to because of the following informalities: the ellipsis (...) on pages 1 and 2 needs to be removed. The ellipsis renders the statements as unfinished.

Appropriate correction is required.

The disclosure is objected to because of the following informalities: the abbreviations for the polymers on P4/L14-16 need to be defined. It is suggested that the Applicants provide proof that it is known that the polymers that is named are abbreviated in this fashion so as to avoid a new matter situation.

Appropriate correction is required.

Claim Objections

Claim 3 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the

claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The instant claim recites that polytetrafluoroethylene is radiation-chemically modified, but the limitation is already recited in claim 1.

Claims 9 and 20 are objected to because of the following informalities: the abbreviations SBS, ABS, SBR, NBR, and NR should be defined. Appropriate correction is required. It is suggested that the Applicants provide proof that it is known that the polymers that is named are abbreviated in this fashion so as to avoid a new matter situation.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 9, it is unclear what “other” co- and terpolymers are since said polymers are undefined.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Nishi et al. (JP 2002-338931 A, see machine translation for citation).

Regarding claims 1, 3, 6-7, Nishi et al. discloses in claims 1-3 and [0026], [0032] a fluorine polymer particle, such as polytetrafluoroethylene polymer particle which is surface modified beyond its melting point with a sodium solution with ionizing radiation under the atmosphere of oxygen and crosslinking with a butadiene/styrene elastic adhesive [0029] after the modified PTFE particles are formed.

Regarding the method limitations of reactive conversion into melt, the examiner notes that even though a product-by-process is defined by the process steps by which the product is made, determination of patentability is based on the product itself. *In re Thorpe*, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985). As the court stated *in Thorpe*, 777 F.2d at 697, 227 USPQ at 966 (The patentability of a product does not depend on its method of production. *In re Pilkington*, 411 F. 2d 1345, 1348, 162 USPQ 145, 147 (CCPA 1969). If the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process). See MPEP § 2113.

Regarding claim 2, Nishi et al. discloses a similar process to the instant claim, therefore it would be inherently true that the bonding site of at least one olefinically unsaturated polymer is randomly distributed on the polymer chain (claims 1-3).

Regarding claims 4 and 5, Nishi et al. discloses a polytetrafluoroethylene powder is radiation-chemically modified with a radiation dose of 1kGy-10MGy which anticipates the claimed ranges.

Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Hamaoka (JP 62036431 A, see translation for citation).

Regarding claims 1 and 3-9, Hamaoka (Claim and P4, Application examples) discloses polytetrafluoroethylene fine powder and an elastomer (i.e butadiene rubber, chloroprene rubber, styrene-butadiene rubber) wherein the composition is allowed to be oriented, then shaped, and irradiated from 1 kGy-1000 kGy (Calculation is based on 100 rad = 1 Gy). Hamaoka discloses the composition can be oriented by extrusion (P4, first full paragraph).

Regarding the method limitations, the examiner notes that even though a product-by-process is defined by the process steps by which the product is made, determination of patentability is based on the product itself. *In re Thorpe*, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985). As the court stated *in Thorpe*, 777 F.2d at 697, 227 USPQ at 966 (The patentability of a product does not depend on its method of production. *In re Pilkington*, 411 F. 2d 1345, 1348, 162 USPQ 145, 147 (CCPA 1969). If the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process). See MPEP § 2113.

Regarding claim 2, Hamaoka (Claim) discloses a similar process to the instant claim, therefore a bonding site of the at least one olefinically unsaturated polymer with the surface is randomly distributed on the polymer would be inherently present in the composition of Hamaoka.

Allowable Subject Matter

Claims 10-19 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: the closest prior arts of record, Nishi et al. (JP 2002-338931 A, see machine translation for citation) or Hamaoka (JP 62036431 A, see translation for citation) does not teach or suggest converting in a melt polytetrafluoroethylene powder and at least one olefinically unsaturated polymer.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 3-7 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of copending Application No. 10/577305.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the corresponding claims recite a radically coupled polytetrafluoroethylene polymer. However, Appln '305 does not recite polymer chemically radically coupled on the surface via a reaction conversion into melt. Regarding the method limitations, the examiner notes that even though a product-by-process is defined by the process steps by which the product is made, determination of patentability is based on the product itself. *In re Thorpe*, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985). As the court stated *in Thorpe*, 777 F.2d at 697, 227 USPQ at 966 (The patentability of a product does not depend on its method of production. *In re Pilkington*, 411 F. 2d 1345, 1348, 162 USPQ 145, 147 (CCPA 1969). If the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process). See MPEP § 2113.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1 and 3 are directed to an invention not patentably distinct from claim 5 of commonly assigned 10/573005.

Claims 1 and 3 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 5 of copending Application No. 10/573005. Although the conflicting claims are not identical, they are not patentably distinct from each other because the corresponding claims recite a radically couple polytetrafluoroethylene polymer. However, Appln '300 does not recite polymer chemically radically coupled on the surface via a reaction conversion into melt. Regarding the method limitations, the examiner notes that even though a product-by-process is defined by the process

steps by which the product is made, determination of patentability is based on the product itself. *In re Thorpe*, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985). As the court stated in *Thorpe*, 777 F.2d at 697, 227 USPQ at 966 (The patentability of a product does not depend on its method of production. *In re Pilkington*, 411 F. 2d 1345, 1348, 162 USPQ 145, 147 (CCPA 1969). If the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process). See MPEP § 2113.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ogata et al. (JP 02072771, see US 5,087,936 for citation) teaches a filter for a camera (Abstract). However, Ogata et al. does not teach or suggest a PTFE composition. Bartoszek-Loza et al. (US 5,169,675) or Noro (JP 63007455) discloses a similar product but does not teach or suggest a PTFE particles.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NICOLE M. BUIE whose telephone number is (571)270-3879. The examiner can normally be reached on Monday-Thursday with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on (571)272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/N. M. B./
Examiner, Art Unit 1796
3/18/2009

/Marc S. Zimmer/

Primary Examiner, Art Unit 1796